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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/608,512	06/27/2003	Kenneth D. Nelson	T-6218 (538-55)	9299

7590 06/19/2006

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EXAMINER

RABAGO, ROBERTO

ART UNIT	PAPER NUMBER
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1713

DATE MAILED: 06/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/608,512

Applicant(s)

NELSON, KENNETH D.

Examiner

Roberto Rábago

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 30 August 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-21, 47-49, 52-54, 57-64, 66-68, 70-72 and 74-79 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-21, 47-49, 52-54, 57-64, 66-68, 70-72 and 74-79 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 September 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>5/23/05; 3/11/05</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Information Disclosure Statement***

1. The information disclosure statement filed 3/11/2005 fails to comply with 37 CFR 1.98(a)(3) because it does not include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information, of each patent listed that is not in the English language. Foreign language reference EP 658572 has not been considered. The mere citation of this reference in a foreign search report does not satisfy the requirement of 37 CFR 1.98(a)(3). This application has not been filed under 35 USC 371, and the identified search report does not correspond to a PCT filing for this application. Accordingly, no foreign language references cited therein will be considered unless such references satisfy the requirements of 37 CFR 1.98(a)(3). As to the actual content of the search report, it contains nothing of substance regarding the significance of the cited reference to the instant claims. Furthermore, no explanation of any kind has been provided by an individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information.

### ***Claim Rejections - 35 USC § 102***

2. Claims 1, 2, 9-21 are rejected under 35 U.S.C. 102(e) as being anticipated by Harrison et al. (US 6,451,920) for the reasons set forth in item 5 of the Office action mailed 4/29/2005.

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Applicant's arguments filed 8/30/2005 have been fully considered but they are not persuasive. Applicants argue that the claimed product is different from the product of Harrison in that the claimed product does not have an acid catalyzed thermal PIBSA component. However, the presence of additional components is not relevant because the claims are entirely open-ended regarding additional components; therefore, the reference meets the claims if a recommended process would result in any of the claimed product, regardless of whether additional components are present. The previously cited disclosure clearly suggests reacting polyPIBSA with a polyol to form an esterified product, and has further suggested using the same polyols as recited in the instant claims. Aside from arguing that the reference uses a process which is different from that described in applicants' specification, applicants' argument provides no basis to conclude that the recommended reference product is not within the scope of the claims.

***Claim Rejections - 35 USC § 103***

3. Claims 3-8, 47-49, 52-54, 57-64, 66-68, 70-72 and 74-79 are rejected under 35 U.S.C. 103(a) as being unpatentable over Harrison et al. (US 6,451,920) for the reasons set forth in item 7 of the Office action mailed 4/29/2005.

Applicant's arguments filed 8/30/2005 have been fully considered but they are not persuasive. As correctly pointed out by applicants, commonly owned subject matter could not be used under 35 USC 103(a) if it qualifies as prior art

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only under 35 U.S.C. 102(e), (f) or (g). However, Harrison qualifies also under 35 U.S.C. 102(a), and therefore the protections of 35 USC 103(c) do not apply.

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

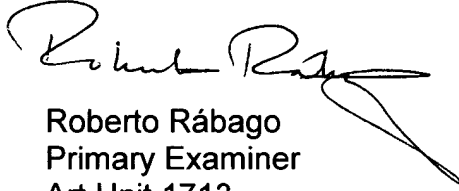
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Roberto Rábago whose telephone number is (571) 272-1109. The examiner can normally be reached on Monday - Friday from 8:00 - 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (571) 272-1114. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Roberto Rábago  
Primary Examiner  
Art Unit 1713

RR  
June 11, 2006